

REMARKS

I. General

Claims 1, 4-16, 19-25, and 27-36 are pending in the present application and stand rejected under 35 U.S.C. § 103(a). Furthermore, the specification stands objected to as well. Applicant respectfully traverses the rejections and objections of record.

Claim 1 has been amended to expressly recite a postal item in the preamble thereof. Accordingly, claim 1 as amended provides express antecedent basis in the preamble for a postal item previously recited in the body of the claim. The amended preamble makes it clear that claim 1 is directed at the combination of an envelope and the postal item, as was and is set forth in the body of the claim.

It is respectfully asserted that the amendment of claim 1 is a properly enterable amendment after final rejection as the amendment does not present new issues requiring further consideration by the Examiner. See M.P.E.P. §714.13. Specifically, claim 1 previously recited a postal item in the body of the claim. The current amendment simply clarifies that the previously amended material cannot be read as non-functional as suggested by the Examiner in rejecting the claim. Moreover, the amended claim should not require a further search of the prior art by the Examiner as the Examiner should have already searched all subject matter which the Examiner reasonably anticipates might be incorporated into Applicant's amendment as directed by M.P.E.P. § 904.02.

II. Objection to the Specification

The objection to the specification questions the status of application 09/491,949 in paragraph number [0001] appearing at page 1. Applicant respectfully asserts that the data contained in paragraph number [0001] accurately reflects the current status of the referenced application. Accordingly, it is respectfully asserted that the objection with respect to the specification should be withdrawn.

III. Premature Final Rejection

Office Actions which introduce a new grounds of rejection not necessitated by the Applicant's amendment shall not be made final. See M.P.E.P. § 706.07(a). Claim 1 has been rejected because "newly added material to claim 1...is directed to nonfunctional descript material that may not distinguish an article over the prior art." Office Action at page 3. However, the material added to claim 1 originally appeared in claims 2 and 3. The Examiner previously had not rejected claims 2 and 3 for the aforementioned reason. Accordingly, the Examiner is introducing new grounds of rejection not necessitated by Applicant's amendment.

Furthermore, the Examiner appears to be combining *Schuessler* with his own experience of using a word processor in rejecting the claims. Office Action at page 5. Because the claims have not previously been rejected under *Schuessler* in view of the Examiner's experience with a word processor, the Examiner is entering further new grounds for rejection. Therefore, Applicant respectfully asserts that the finality of the Office Action is improper. Accordingly, Applicant respectfully request, pursuant to M.P.E.P. § 706.07(c), that the Examiner reconsider the final status of the Office Action and withdraw the finality of the rejection pursuant to M.P.E.P. § 706.07(d).

IV. The 35 U.S.C. § 103 Rejections

Claims 1, 6-16, 21-25, and 27-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schuessler* in view of legal precedent stating it is obvious to replace manual activity with automatic activity as set forth in *In re Venner and Bowser*, 120 U.S.P.Q. 192, 194 (CCPA, 1958). Claims 4, 5, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Schuessler* in view of either Sansone et al., United States patent number 4,724,718 (hereinafter *Sansone*), Gunn, Great Brittan patent number 1380590 (hereinafter *Gunn*), or Gilham, European patent number 0331352 (hereinafter *Gilham*).

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of the ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the references lack all the claim limitations and proper motivation.

A. Claimed Structure Ignored as Being “Non-Functional Descriptive Material” Must be Given Patentable Weight

Regarding claim 1, the Examiner stated “the newly added material to claim 1...is directed to nonfunctional descript [sic] material.” Final Office Action page 3. Applicant respectfully asserts that express recitation of a postal item bearing a postal indicia, wherein the postal item is a computer generated document, and the postal indicia is printed on the postal item at the time of generation is not non-functional descriptive material. The foregoing recites specific structure of the claimed combination and cannot be summarily disregarded by the Examiner when considering the patentability of the claims. M.P.E.P. § 2143.03. Accordingly, the Examiner must give all the limitations of claim 1 patentable weight.

In an effort to expedite prosecution, the preamble of claim 1 has been amended to read “An envelope and a postal item comprising” thereby resulting in a claim which is unequivocally directed to word an envelope and postal item. It is believed that the foregoing amendment redresses the Examiner’s consternation with respect to the claim being “directed to an article, that is an ‘envelope’ and not either the contents of the envelope or a combination of the envelope and the contents of the envelope.” Office Action at page 3.

B. Rejections Based Upon *Schuessler* in View of The Legal Precedent

1. The Combination Fails to Teach all the Claim Limitations

Regarding the limitations of claims 1, 16, 25, and 36, the Office Action states that *Schuessler* suggests “it is desirable to reduce the time required to complete forms to make this process more efficient” and “the information that is to be placed in specified locations on the contents of the envelope is performed manually by the user.” Final Office Action at page 4. The Final Office Action further states that “it is well known that the use of a computer to complete and generate various forms speeds up the processing of the forms as a whole,” and

therefore concludes that “it would have been obvious to one of ordinary skill at the time of the invention that the manual completion of contents 10 of the envelope 31 by the user of *Schuessler* (‘323) could be automatically performed by a computer system in order to save time and make the process more efficient.” *Id.*

Applicant respectfully asserts that one of ordinary skill in the art would not have been enabled to modify the system of *Schuessler* to replace the manual completion of the deposit ticket thereof with automatic completion of the deposit ticket using a computer system as proffered in the Final Office Action. In column 3, lines 11-27, *Schuessler* teaches the depositor writing deposit entries upon the deposit ticket, using carbon if a copy is desired, and affixing an adhesive stamp to the deposit ticket. The general knowledge that it is desirable to automate manual activity in order to save time and make the process more efficient is insufficient to have enabled one of ordinary skill in the art to have created a computer system not only capable of automatically completing each of portions 21, 26, and 16 of deposit ticket 10, but also to generate and print a postage indicia within stamp section 30 with no other guidance whatsoever. The present specification provides great detail with respect to systems to enable the foregoing which, without the benefit of hindsight gleaned from the Applicant’s own specification, would not have been obvious to one of skill in the art from a review of *Schuessler* or other art available at the priority date attributable to the present claims.

In addition, claims 1 and 16 require the postal item and postage indicia be printed at the same time. Column 3, lines 11-12 in *Schuessler* teaches a deposit ticket provided by the bank, and column 3, line 13 explains a depositor makes deposit entries upon the deposit ticket at a later time. Although *Schuessler* discusses affixing a postage stamp or a mail permit stamp to the deposit ticket, *Schuessler* does not teach or suggest affixing such a stamp to the deposit ticket at the time of printing the deposit ticket. Column 2, lines 48-50. Accordingly, the limitations of claims 1 and 16 are not met because there is nothing to have suggested printing a postage indicia directly upon the postal item at the time of printing the postal item. As such, claims 1 and 16 are patentable over the 35 U.S.C. § 103 rejections of the record.

In responding to the foregoing arguments, the Examiner states that “this examiner has used computerized word processing applications since the early nineteen nineties” and that “one of ordinary skill would have been readily able to automate, without undue experimentation, the implementation of completing of the form of *Schuessler* (2,964,323) by a computer.” Office Action at page 5. The Examiner’s statement assumes that simply automating completion of the form of *Schuessler* is all that is required to meet the claims. However, merely automating that which is taught in *Schuessler* would not meet the claims.

For example, the deposit ticket of *Schuessler* is expressly taught to be provided to the depositor by the bank. Column 3, lines 11-12. Accordingly, automating completion of the previously printed deposit ticket by the depositor, whether using a computerized word processing application or other means, would not result in a computer generated document bearing a postal indicia, wherein the postage indicia is printed directly upon the computer generated document at the time of printing the computer generated document (claim 1). Similarly, automating completion of the previously printed deposit ticket by the depositor would not result in a computer generated piece of correspondence having a postage indicia placed thereon simultaneously with printing the piece of correspondence (claim 16). Likewise, automating completion of the previously printed deposit ticket by the depositor would not result in a piece of correspondence and a postage indicia thereon printed by a computer system (claim 25) or generating a piece of correspondence having a postage indicia thereon using a computer system (claim 36). At best, the Examiner’s proffered modification would result in completing a document by a computer rather than generating or printing a document or correspondence.

Moreover, although the Examiner asserts that one of ordinary skill in the art would have been readily able to automate completing of the form of *Schuessler* without undue experimentation, there is nothing in the art of record to show that the features of the claims were within the level of the skill in the art. For example, there is nothing of record to show that one of skill in the art would have been able to print postage indicia from a computer system. Moreover, there is nothing of record to show that one of skill in the art, even those experienced in the use of computerized word processing applications, would have been able to integrate printing of postage indicia from a computer with printing of a document or

correspondence by a computer. The Examiner's bald statements that merely automating the manual process of *Schuessler* would meet the claims ignores both the complexity of accomplishing the particular tasks using a computerized system and the level of integration expressly recited in the claims. Accordingly, the 35 U.S.C. § 103 rejections of record are improper and should be withdrawn.

2. The Combination Lacks Proper Motivation

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima face obvious. M.P.E.P. § 2143.01 (citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959)). *Schuessler* teaches a system in which preprinted deposit tickets are provided by a bank to a depositor. Column 3, lines 11-12. Thereafter, the depositor completes the deposit ticket and mails it back to the bank. Column 3, line 13 and lines 32-40. The bank will enter the deposit and return a deposit receipt and another deposit ticket to the depositor by return mail. Column 3, lines 41-47. If the depositor were to generate their own deposit tickets, the foregoing principle of operation set forth in *Schuessler* would be changed.

In rejecting the claim the Examiner states that "it would have been obvious to one of ordinary skill at the time the invention that the manual completion of contents 10 of the envelope 31 by the user of *Schuessler* ('323) could be automatically performed by a computer system in order to save time and make the process more efficient." Office Action at page 4. However, assuming *arguendo* that the foregoing is accurate, the statement establishes nothing more than the reference could have been modified. The mere fact that reference can be modified does not render the resulting modification obvious unless the prior art also suggests the desirability of the modification. M.P.E.P. 2143.01. There is nothing in the disclosure of *Schuessler* to have suggested automation of completion of the deposit ticket. Moreover, the Examiner's statement that such automation could be done "in order to save time and make the process more efficient" suffers from the assumption that any automation results in time savings and efficiency. However, Applicants respectfully assert that attempting to insert the preprinted deposit ticket of *Schuessler* into a computerized printer, controlling the printer to complete the deposit ticket in the appropriate locations, and controlling the printing to

complete the receipt portion of the deposit ticket would likely result in considerably more time and less efficiency than an individual completing the deposit ticket manually.

Accordingly, proper motivation for the Examiner's proffered modification has not been made of record. Thus, the motivation provided by the Examiner is improper, and the claims are patentable over the 35 U.S.C. §103 rejections of record.

C. Rejections Based on *Schuessler* in View of a Word Processor

In order to reject a claim based on combined references, the Examiner should set forth in the office action, the relevant teachings of the prior art relied upon, the difference or differences in the claim over the applied references, the proposed modification of the applied references necessary to arrive at the claimed subject matter, and an examination of why one with ordinary skill in the art would be motivated to make the proposed invention. M.P.E.P. § 706.02(j). In response to Applicant's arguments in the previous Amendment, the Examiner explained "since applicant has chosen to include the use of a computer in the instant claims and this examiner has used computerized word processing applications since the early nineteen nineties, one of ordinary skill would have been readily able to automate, without undue experimentation, the implementation of completing of the form of *Schuessler* (2,964,323) by a computer." In order to have a fair opportunity to reply, Applicant respectfully requests the Examiner provide Applicant with an Office Action detailing the 35 U.S.C. § 103 rejection regarding *Schuessler* in view of a word processor as required by M.P.E.P. § 706.02(j).

While Examiner has not yet properly applied a 35 U.S.C. § 103 rejection regarding the combination of *Schuessler* in view of a word processor, in an attempt to fully answer the final Office Action, Applicant will attempt to address Examiner's statements on page 5 regarding the use of a computerized word processor. Applicant respectfully asserts that one of ordinary skill in the art familiar with the use of computerized word processing systems would not have been enabled to modify the system of *Schuessler* to replace the manual completion of a stamped deposit ticket with the automatic completion of a stamped deposit ticket using a word processor as suggested by the Examiner. The present specification provides great detail with respect to a system enabling printing postal indicia with a computer system which, without the benefit of hindsight gleaned from the Applicant's own

specification, would not have been obvious to one of skill in the art from a review of *Schuessler* in view of a word processor. The Examiner has not provided any motivation for a word processor to take the steps necessary in order to generate postal indicia using a computer or to provide integration to the level to facilitate printing of a computer generated document or correspondence and a postage indicia. As result, the proposed combination not only fails to teach all the limitations of the claims but the Examiner has also failed to provide the proper motivation thereof. Therefore, Applicant respectfully contends the claims are patentable under 35 U.S.C. § 103 over *Schuessler* in view of a word processor.

D. Rejections Based Upon *Schuessler* in View of *Sansone*, *Gunn*, or *Gilham*

Claims 4, 5, 19, and 20 depend from independent claims 1 and 16 respectively and thus incorporate the limitations therein. Applicant has shown above that *Schuessler* does not teach or suggest the limitations of the independent claims. The rejections of record with respect to dependent claims 4, 5, 19, and 20, relying upon the disclosure of *Sansone*, *Gunn*, or *Gilham*, do not cure the above identified deficiencies in *Schuessler*. Furthermore, Applicant's review of the disclosure of *Sansone* does not reveal a postmark with a machine readable portion or a barcode, instead *Sansone* discusses a motor vehicle gear shift. Therefore, dependent claims 4, 5, 19, and 20 are asserted to be patentable over the 35 U.S.C. § 103 rejections of the record at least for the reasons set forth above with respect to independent claims 1 and 16.

V. Summary

In view of the above amendment, applicant believes the pending application is in condition for allowance.

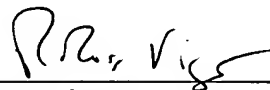
Application No.: 10/082,398

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P004CP1CP1C2/10107404 from which the undersigned is authorized to draw.

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Respectfully submitted,

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